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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/475,703	12/30/99	SLUSAREK	W 78738EAR

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EXAMINER

CHEA, T

ART UNIT

PAPER NUMBER

1752

DATE MAILED:

12/20/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

Office Action Summary

Application No.

09/475,703

Applicant(s)

SLUSAREK ET AL.

Examiner

Thorl Chea

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-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) 21-41 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20, drawn to imaging material, classified in class 430, subclass 619.
 - II. Claims 21-27, drawn to process, classified in class 430, subclass 336.
 - III. Claims 28-34, drawn to a process, classified in class 356, subclass 3.09.
 - IV. Claims 35-37, drawn to process, classified in class 399, subclass 32.
 - V. Claims 38-39, drawn to process, classified in class 356, subclass 30.
 - VI. Claim 41, drawn to process, classified in class 430, subclass 350.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions Group I to Group VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions, the process of group VI contains no compound of Group I. The processes of groups II related to the use of the imaging material in the formation of an image. The process of Group III is related to the scanning of the image after the development of imaging material. The process of Group IV is related to the storing, transmitting or displaying the imaging material after development. The process of group VI is related to the process of using the imaging element in one-time-use camera. Therefore, the inventions of Groups I to VI are distinct.

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3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Edith A. Rice on November 1, 2000 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-41 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

DETAILED ACTION

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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The specification fails provide an adequate written description as how to make the compound wherein PUG is a coupler, color inhibitor, inhibitor releasing developer, dyes precursor, silver ion fixing agent, electron transfer agent, silver solvent, silver halide complexing agent, reductone, image toner, pre-processing or post-processing image stabilizer, hardener, tanning agent, ultraviolet radiation absorber, nucleator, chemical or spectral sensitizer, desensitizer, surfactant, or precursors thereof. The specification fails to provide a process as how to connect that recited PUG to the structure of formula (I). In the absence of providing a process of linking of each of PUG to the general formula (I), it would not be possible for the worker of ordinary skill in the art to form the compound within the scope of the claimed PUG to make the claimed material and process.

The specification fails to provide an adequate written description of "link 1" and "link2". A specific examples of "link 1" and "link2" may be provided in the preferred embodiment. However, the scope thereof appears to be extending beyond the exemplified groups. In the absence of providing a clear guidance as how to select the link 1 and link 2, it would not be possible to the skill in the art to select the link1 and link2 other than the exemplified link1 and link2 to make the compound within the scope of formula I .

Also, the specification fails to provide an adequate written description of the "electron-withdrawing group" presented in claims 1 and 11.

The specification fails to clearly describe the term "ring" presented in claims 1 and 11.

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8. Claims 1-2, 6-10, 12, 14-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the developing agent as PUG, does not reasonably provide enablement for the coupler, color inhibitor, inhibitor releasing developer, dyes precursor, silver ion fixing agent, electron transfer agent, silver solvent, silver halide complexing agent, reductone, image toner, pre-processing or post-processing image stabilizer, hardener, tanning agent, ultraviolet radiation absorber, nucleator, chemical or spectral sensitizer, desensitizer, surfactant, or precursors thereof specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. The specification discloses only the compound of the preferred embodiment wherein the PUG is a developer.

9. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for photographic, photothermographic and thermographic imaging layer, does not reasonably provide enablement for any other imaging layer. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims. Only photographic, photothermographic, and thermographic element are disclosed in the specification.

10. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for link1 and link2 provided on page 9 of the specification, does not reasonably provide enablement for other link1 and link2. The specification does not enable any person skilled in the art to which it pertains, or with

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which it is most nearly connected, to make the invention commensurate in scope with these claims. No other guidance as how to select link1 and link2 other than those exemplified on page 9 was provided.

11. Claims 1-20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The scope of protection sought for the "ring" and "bicyclic substituent" in claim 1, 11 are indefinite for the specification fails to define the scope thereof or the ring or the bicyclic substituent really is.

The scope of "linking group" in claim 1 is unclear since the specification provides only a specific structure in the preferred embodiment. However, the term "linking group" appears to extending to group outside the preferred embodiment. Thus, the scope thereof is indefinite. The scope of protection sought for X as "electron withdrawing group" in claim 1 and 10 is indefinite. The subscript "1" for "(Link 1)₁" in for the formula I in claim 1 render the claim confusing since that subscript and the number "1" is the same. Note for instance the language "if X is a sulfono group and a and 1 are each 1". The claiming of X as "sulfono" group in claim 1 and 11 is unclear whether it means "sulfone", "sulfonyl" or otherwise. The definition of "a" and "b" in claims 1, and 11 is not clear. Note for the language in claim 1 such as "if X is a sulfono group and a and 1 are each 1 and n and m are each 0, then t is 1 or 2; and if t is 2 the two T groups can combine to form a ring; b is 1 when X is divalent and o when X is monovalent, and the language in claim 11 wherein "a is 1 when X is monovalent and 1 and 1 or 2 when X is

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divalent; b is 0 when X is monovalent and 1 when X is divalent. The value of a and b is not defined when X other than sulfono group.

12. The following is a statement of reasons for the indication of allowable subject matter: claimed invention would be allowable if amended to overcome the rejection under 35 USC 112 above. The closest reference such as Buchanan et al ('783) may disclose a blocked photographically useful compound, but the structure thereof is outside the scope of the claimed invention.

Double Patenting

13. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

14. Claims 1-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-20 of copending Application No. 09/614,035. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented. Claimed invention of both copending application are identical.

15. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is

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requested in correcting any errors of which applicant may become aware in the specification.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thorl Chea whose telephone number is (703)308-3498. The examiner can normally be reached on M-F (9:30 - 6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet C Baxter can be reached on (703)308-2303. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-3599 for regular communications and (703)305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Thorl Chea
Primary Examiner
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tchea 
December 3, 2000